

REMARKS

Applicants have carefully considered the Decision on Appeal mailed December 23, 2002. Re-examination and re-consideration of the claims by the Examiner are respectfully requested.

The Board rejected claims 7-9 and 11-21 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention. The board objected to the term "end" in the claim being described as having a cylindrical cross-section, a taper, parallel side walls, or a portion of a particular diameter. Appellants have amended the claims to delete the term "end" and replace it with the term "section". A "section," as alluded to by the Board, is capable of having a cylindrical cross-section, a taper, parallel side walls, etc. The claims are now in accordance with §112, second paragraph. Accordingly, it is submitted that the rejection under §112 has been resolved.

Due to the Board finding the claims 7-9 and 11-21 indefinite, the Board did not address the issue of obviousness for claims 7-9 and 11-21. Nevertheless, the Board instructed that its reason articulated in refusing to sustain a rejection of claims 1-3 under §102 and claims 5 and 6 under §103 should not be overlooked in the future prosecution of claim 7-9 and 11-21.

Since the basis of all the obviousness rejections, including claims 7-9 and 11-21, relies on Akatsuka '450 the reasoning applied by Board in reversing the Examiner's rejections should also apply to claims 7-9 and 11-21. The Board did not agree with the Examiner's conclusion that the ranges disclosed in Akatsuka '450 encompass the ranges for the butt end recited in claim 1. Furthermore, in reversing the Examiner's obviousness rejections, the Board refused to combine Akatsuka '450 with Hogan because, in the view of the Board, Akatsuka '450 failed to provide any motivation to produce a club having dimensions that read on claim 1. Claims 7-9 and 11-21 recite similar dimensions to claim 1. Accordingly, it is submitted that claim 7-9 and 11-21 are in accordance with §112, second paragraph and also define over the cited references both individually and properly combined. ☒

CONCLUSION

For the reasons detailed above, it is respectfully submitted claims 7-9 and 11-21 are now in condition for allowance. An early notice to that effect is therefore earnestly solicited.

Respectfully submitted,

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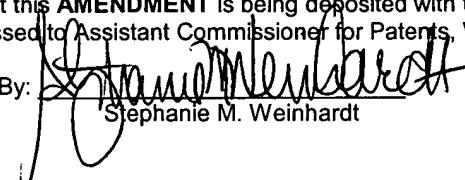


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CERTIFICATE OF MAILING

I hereby certify that this **AMENDMENT** is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on February 21, 2003.

By:



Stephanie M. Weinhardt

APPENDIX: Version to Show Changes Made to Claim

7. (Thrice Amended) A composite golf club shaft comprising:
an elongated tubular shaft comprising a plurality of layers of fiber embedded in a synthetic resin, said elongated tubular shaft having a butt [end]section comprising a substantially cylindrical cross section of relatively larger cross section, which transitions without intervening discontinuities to a tapered intermediate section, said tapered intermediate section tapering without intervening discontinuities to a relatively smaller diameter tip [end]section; said tip [end]section including a portion having an outside diameter of between .330 and .400 inches;
said butt [end]section having an outside diameter between .400 to .540 inches, said [end]section diameter displacing a kick point above a center pint of the composite golf club shaft.

8. (Amended) The golf club shaft of claim 7, wherein;
said butt [end]section has a wall thickness between .04 and .045 inches.

13. (Thrice Amended) A composite golf club shaft comprising:
an elongated tubular shaft comprising a plurality of layers of fiber embedded in a synthetic resin, said elongated tubular shaft having a butt [end]section comprising a substantially cylindrical cross section of relatively larger cross section having an outside diameter between .400 and .540 inches, which transitions without intervening discontinuities to a tapered intermediate section, said tapered intermediate section transitioning without intervening discontinuities to a relatively smaller diameter tip [end]section, said tip [end]section including a portion having an outside diameter adapted to be fitted to the hosel of a club head, said butt [end]section diameter displacing a kick point above a center point of the golf club shaft.

15. (Amended) The shaft of claim 14 wherein the butt [end]section includes parallel sidewalls.

16. (Amended) The shaft of claim 15 wherein the tip [end]section includes parallel sidewalls.

17. (Amended) The golf club shaft of claim 13 wherein said butt [end]section includes

at least one cross-section diameter between .450 and .475 inches.

19. (Twice Amended) A golf club shaft comprising:

an elongated tubular shaft, said elongated tubular shaft having a butt [end]section comprising a substantially cylindrical cross section having an outside diameter of between .400 and .560 inches, which transitions without intervening discontinuities to a tapered intermediate section, said tapered intermediate section transitioning without intervening discontinuities to a relatively smaller diameter tip [end]section, said tip section having an outside diameter of between .330 and .400 inches, and said tapered intermediate section having a more significant taper than both said butt and tip [ends]sections.

20. (Amended) The shaft of claim 19 wherein said tip section and said butt [end]section include parallel sidewalls.

21. (Twice Amended) A golf club shaft comprising:

an elongated tubular shaft having a length of between about 35 and 47 inches, said elongated tubular shaft having a butt [end]section of relatively larger cross sectional diameter tapering without intervening discontinuities to a tip [end]section of relatively smaller diameter, said tip [end]section having an outside diameter between .330 and .400 inches;

said butt [end]section having at least one portion with an outside diameter of between .400 and .540 inches, said butt [end]section diameter displacing a kick point toward the butt end of the shaft.